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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,057	06/06/2001	Takehiro Nishiyama	209396US-2X	5638
22850	7590	09/28/2006	EXAMINER	
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RUHL, DENNIS WILLIAM	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/874,057	Applicant(s) NISHIYAMA, TAKEHIRO	
	Examiner Dennis Ruhl	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/06 has been entered.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claim 17, with respect to the language "and under course of or out of operation..", what does the "and under course of" portion intend to recite? Under course of what? It does not make sense to read this portion as "under course of operation" because that seems to be already taken care of in the limitation of "rented". What does the language "under course of ?" recite? The language "as the searched result displaying information related to.." is considered indefinite. It appears that this portion is attempting to claim a method of use limitation in an article claim. Is applicant claiming the displaying of information like a method step? The amended portion of the claim renders the claim indefinite.

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-21 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Janssen (5754850).

For claims 17,18,20,21, Janssen discloses a system and method that relates to *“the field of computer search methods. More particularly the present invention relates to a method and apparatus for searching a database for items satisfying specific features or closely satisfying specific features.”* (See the Field of the Invention section of Janssen). Janssen also discloses in column 8, lines 48-54, that the method is contemplated as being performed “on-line” and can be used for purposes other than real estate such as finding a lawyer, finding a loan, or finding an apartment. The examiner takes official notice that apartments are an item that is well known as being rented. Janssen recognizes the use of the system and method for apartments, which are rentals. Janssen discloses that the information about available items (items for sale or rent or services available for hire, or whatever the intended use of the system is) is

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downloaded to a computer by using a modem 270. See figure 2 and column 4, lines 10-11. This inherently requires the use of a first terminal as claimed and satisfies the functional language relating to the 1st terminal. One must necessarily have a first terminal that communicates with modem 270 to update the information on file. The 2nd terminal is also considered inherent because Janssen discloses that the invention can be done "on-line". This requires that the customer desiring a rental has a 2nd terminal that they use to submit the search query describing what they want as far as a rental goes (or whatever the system is being used for and whatever you are searching for). The network server is 200 and the means for holding data is database 210. The database 210 holds data relating to whatever the system is being used for. This includes data such as specification (kind of apartment, 1 bedroom, 2 bedroom, etc.); location; and time period (when is apartment needed or how long of a lease is desired?). This kind of information necessarily is involved in the rental process for apartments. If apartments are listed the data will include the kind of apartment, location, and availability. The "means for searching" is the software disclosed in column 4, lines 2-4. The means for providing a searched result is present in Janssen because it is disclosed that the results are given to the customer. After all that is the reason you are using the system anyway, to get results to your search. With respect to the "means for providing the second terminal with the information" related to the search result, this is interpreted to be the hardware/software that allows the searched result to be sent to the 2nd terminal. This can include a modem and the modem driver software that would allow the data related to the search result to be transmitted to the customer at the 2nd

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terminal. With respect to the kind of data being claimed (i.e. whether the item is rented, under course of negotiations, under course of ??, or out of operation) and how it is presented, this data is not actually being positively recited in the claim because it is directed to the intended use of the system. In other words, the kind of data claimed is just the data that is intended to be sent to the 2nd terminal by the recited "means for providing the second terminal" with the search result. The fact that the result is in the form of a calendar does not matter and is not part of the scope of the recited means language, because the claimed "means for providing the second terminal with the information" is covering the structure that provides the search result data to the 2nd terminal, nothing more. However, the result in Janssen for the example of an apartment would include whether or not the apartment is rented or vacant. The examiner further notes that the data related to the search result is directly dependent on the kind of data you are searching (what are you looking for, a lawyer, an apartment, a loan, etc.) and would naturally flow from the intended use of the system. In Janssen it is disclosed that the user can specify certain search criteria as being primary and others as non-primary. This satisfies the claimed limitation of having an option that allows the identification of a preferred option for one of the search criteria. Janssen discloses this feature. Janssen searches for the primary features first and will then search the results for the non-preferred options. With respect to the fact that the claims are reciting that the system is for the renting of a construction machine and the kind of data the search result is intended to produce, this is directed to the intended use of the system and must result in a structural difference when compared to the prior art. In this case there is no

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difference between the prior art. The fact that the data for location, specification and time period are intended for or describe construction machines does not define over the same kind of data that would be used for apartments. The data involved in construction machines and apartments is the same, namely, location, specification (kind of apartment), and time period. The fact that the data is relating to construction machines is not important because the data variables themselves are disclosed in Janssen and are dependent on the intended use of the system. If you are looking for a loan, the result of the search request would include data relevant to loans. If you are looking for a lawyer, the result of the search would include data relevant to lawyers. Additionally, the language describing that the 2nd terminal is "configured to enable" the inputting of certain information (search criteria) is very broad and is really just claiming that the terminal is capable of allowing input of data and this is not claiming the data as being stored in a positive sense. Any computer with an input device such as a keyboard is capable of inputting any kind of information you desire.

With respect to the limitations directed to the data that is able to be inputted into the system and searched by the system, the examiner has two comments. The first is that the language "configured to enable" only means that the terminals must be capable of allowing one to enter data. This does not mean or require the claimed type of data. The data is just the intended use of the system. Second comment is that data is data, and claiming that certain data that represents construction machines is being searched or is able to be inputted is not defining anything further to the system in a structural sense.

In the alternative, under section 103, if one decided that Janssen did not disclose the same structure that the claimed “means for providing the second terminal with the information related to the construction machine for rent as a calendar” covers, and one interpreted this language to require Janssen to disclose a calendar format for a search result to be a proper rejection, the examiner offers the following comments. The use of calendars to display data relating to rental items is old and well known. Rental agencies that rent out homes have for a long time used calendars to show when certain homes are rented, vacant, or just not available. A calendar is a very useful format for displaying information when the issue of time and dates is involved. One of ordinary skill in the art at the time the invention was made would have found it obvious to display the search result by using a calendar format, because this format is well known to be very useful to display information when dates and time are involved, such as the dates when something is available or not available. A calendar is a very well known tool that allows one to display information and relate that information to dates and time. One of ordinary skill in the art would have recognized this and this is something that is within the knowledge that one of ordinary skill in the art would possess. The examiner also notes that the issue of the use of a calendar for the search results was set forth as being obvious in the very first office action in this case with respect to original claim 11, and applicant failed to provide any rebuttal to this issue as was required by 37 CFR 1.111 if applicant disagreed with the position of the examiner.

For claim 19, reciting what the machine is that is for rent defines nothing further to the claimed system. The kind of machine is directly related to the intended use of the

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system and what the item is that is being rented. Janssen satisfies what is claimed because this claim defines nothing further to the system of claim 17.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Janssen (5754850) in view of the newswire article of 2-3-2000 "United Rentals, Inc. Launches Business to Business Equipment E-Rental Store". In this rejection the examiner is giving much more weight to the intended use of the system than in the 102 rejections to more fully address the actual intended use recited. The examiner also has addressed the issue of the use of a calendar in two manner, one where Janssen satisfied this limitation and one where it is addressed via section 103.

For claims 17,21, Janssen discloses a system and method that relates to "*the field of computer search methods. More particularly the present invention relates to a method and apparatus for searching a database for items satisfying specific features or closely satisfying specific features.*" (See the Field of the Invention section of Janssen). Janssen also discloses in column 8, lines 48-54, that the method is contemplated as being performed "on-line" and can be used for purposes other than real estate such as finding a lawyer, finding a loan, or finding an apartment. The examiner takes notice that

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apartments are an item that is well known as being rented. Janssen recognizes the use of the system and method for apartments, which are rentals. Janssen discloses that the information about available items (items for sale or rent or services available for hire, whatever the intended use of the system is) is downloaded to a computer by using a modem 270. See figure 2 and column 4, lines 10-11. This inherently requires the use of a first terminal as claimed and satisfies the functional language relating to the 1st terminal. One must necessarily have a first terminal that communicates with modem 270 to update the information on file. The 2nd terminal is also considered inherent because Janssen discloses that the invention can be done "on-line". This requires that the customer desiring a rental has a 2nd terminal that they use to submit the search query describing what they want as far as a rental goes. The network server is 200 and the means for holding data is database 210. The database 210 holds data relating to whatever the system is being used for. This includes data such as specification (kind of apartment, 1 bedroom, 2 bedroom, etc.); location; and time period (when is apartment needed or how long of a lease is desired?). This kind of information necessarily is involved in the rental process for apartments. If apartments are listed the data will include the kind of apartment, location, and availability. The "means for searching" is the software disclosed in column 4, lines 2-4. The means for providing a searched result is present in Janssen because it is disclosed that the results are given to the customer. After all that is the reason you are using the system anyway, to get results to your search. With respect to the "means for providing the second terminal with the information" related to the search result, this is interpreted to be the hardware/software

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that allows the searched result to be sent to the 2nd terminal. This can include a modem and the modem driver software that would allow the data related to the search result to be transmitted to the customer at the 2nd terminal. The fact that the result is in the form of a calendar does not matter and is not part of the scope of the recited means language, because the claimed "means for providing the second terminal with the information" is covering the structure that provides the search result data to the 2nd terminal, nothing more. In Janssen it is disclosed that the user can specify certain search criteria as being primary and others as non-primary. This satisfies the claimed limitation of having an option that allows the identification of a preferred option for one of the search criteria. Janssen discloses this feature. Janssen searches for the primary features first and will then search the results for the non-preferred options.

Not disclosed in Janssen is that the system and method is used renting of construction machines.

The newswire article discloses that United Rentals has opened on "on-line" E rental store for renting of equipment such as construction equipment, heavy machinery, and other types of equipment. Because Janssen discloses that the system and method can be used for things such as searches for "*home loans, schools, doctors, cars, apartments, vacation packages, lawyers, and CPA's*" and the system can also be used "on-line", it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the system of Janssen for the rentals of equipment such as construction equipment and machines, as the newswire article discloses. The system of Janssen can be used for any kind of activity where searching for something is

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involved. One of ordinary skill in the art would find the use of Janssen obvious for construction machines in view of the fact that United Rentals is renting equipment "on-line". The recited intended use of the system is a choice that is obvious to one of ordinary skill in the art. With respect to the search result, when one of ordinary skill in the art is using the methodology and system of Janssen with construction machine rentals, one of ordinary skill in the art would appreciate or understand that the results would contain data such as whether or not the available (rented or vacant or out of service at the present time, etc.) The examiner feels that the claimed data would naturally flow from the fact that the intended use of the system is for the rental of construction machines.

For claim 18, Janssen discloses upper location information which is the entered zip code. This defines an area or a location. The lower location information is a location such as "near the ocean" or "walking distance to public transportation". These are both locations within the more broad location defined by the zip code. In Janssen the zip code is a preferred search term (primary) and the features such as being near the ocean or near public transportation are disclosed as being non-preferred search criteria. Janssen searches as has been claimed.

With respect to claim 19, the recitation that the machine is a tracklaying machine is defining nothing further to the system and is satisfied by Janssen. The construction machine is what is being rented and is not part of the system. At best, this limitation is non-functional descriptive material that just describes what the item is that is being rented. Additionally, when one is using the system of Janssen for the rental of

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construction equipment as the 103 rejection does, one of ordinary skill in the art would appreciate that this includes machines such as a tracklaying machines.

For claim 20, Janssen discloses what is claimed because the information about what is available (specification information) can be searched as claimed. The user can specify that they are looking for an apartment (upper class), and then further specify that they want a two-bedroom apartment (lower class). This is information in hierarchal form. This satisfies what is claimed. The language about the data defining something that is easy to change or not easy to change is just descriptive about the data itself and gets minimal weight.

With respect to the use of a calendar, in the alternative, under section 103, if one decided that Janssen did not disclose the same structure that the claimed "means for providing the second terminal with the information related to the construction machine for rent as a calendar" covers, and one interpreted this language to require Janssen to disclose a calendar format for a search result to be a proper rejection, the examiner offers the following comments. The use of calendars to display data relating to rental items is old and well known. Rental agencies that rent out homes have for a long time used calendars to show when certain homes are rented, vacant, or just not available. A calendar is a very useful format for displaying information when the issue of time and dates is involved. One of ordinary skill in the art at the time the invention was made would have found it obvious to display the search result by using a calendar format, because this format is well known to be very useful to display information when dates and time are involved, such as the dates when something is available or not available.

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A calendar is a very well known tool that allows one to display information and relate that information to dates and time. One of ordinary skill in the art would have recognized this and this is something that is within the knowledge that one of ordinary skill in the art would possess. The examiner also notes that the issue of the use of a calendar for the search results was set forth as being obvious in the very first office action in this case with respect to original claim 11, and applicant failed to provide any rebuttal to this issue as was required by 37 CFR 1.111 if applicant disagreed with the position of the examiner.

9. Applicant's arguments filed 1/30/06 have been fully considered but they are not persuasive. With respect to the "means for providing" the 2nd terminal with the information" about the search result in the form of a calendar, as stated in the rejection of record this is interpreted to be the hardware/software that allows the searched result to be sent to the 2nd terminal. This can include a modem and the modem driver software that would allow the data related to the search result to be transmitted to the customer at the 2nd terminal. This is different from structure that would create the search result in a particular format. The means to provide the search result to the 2nd terminal is just providing the data that was already created and formatted by another element of the device. Applicant's argument is non-persuasive. Additionally, this issue was addressed in the first office action (claim 11) and applicant failed to rebut the position of the examiner with any kind of traversal.

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With respect to the search result data itself, the data related to the search result is directly dependent on the kind of data you are searching (what are you looking for, a lawyer, an apartment, a loan, etc.) and would naturally flow from the intended use of the system. The examiner does not find the data to be positively recited in the article claims because the data is just what is intended to be provided to the 2nd terminal by the “means for providing the 2nd terminal” limitation and as stated previously is totally dependent and flows from the intended use of the system. If you are looking for a loan, the result of the search request would include data relevant to loans. If you are looking for a lawyer, the result of the search would include data relevant to lawyers. The argument is non-persuasive.

With respect to the 112,2nd rejection, the examiner does not find the comments to be persuasive. There is no showing of where in the specification as originally filed support can be found for the definition offered by applicant's counsel. The counsel for applicant cannot introduce the definition and explain the scope of the claim language, the specification must do this.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DENNIS RUHL
PRIMARY EXAMINER